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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,891	12/11/2003	Patrick Young	ST-008 Div. 2 FWC Cont. 2	1556
75563	7590	06/09/2011	EXAMINER	
ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			HASAN, SYED Y	
			ART UNIT	PAPER NUMBER
			2484	
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			06/09/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/733,891	Applicant(s) YOUNG, PATRICK	
	Examiner SYED HASAN	Art Unit 2484	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/29/2011</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1 - 20 filed on 03/23/2011 have been considered but are moot in view of the new ground(s) of rejection.

In re page 6 applicant argues with respect to claim 1 that "Claim 1 and amended claim 8 define a technique for controlling a television tuner. A first channel selection command corresponding to a selected television program is received, where the first channel selection command unrecognizable by the television tuner. The first channel selection command is converted to a second channel selection command, where the second channel selection command is recognizable by the television tuner. The television tuner uses the second channel selection command to tune to the selected program."

In response examiner presents the disclosure of Beyers Jr. (US 4641205). Beyers Jr. discloses that "In playback mode of operation, video and audio signals developed by heads 13 from a tape are processed by respective playback processing units 21 and 23 and coupled to an RF modulator 25. Modulator 25 produces an RF carrier corresponding to a predetermined channel (e.g., channel 3 or 4) which is modulated with television information corresponding to the recorded material in the same format as the RF carriers received from RF source 1. The RF carrier produced by modulator 25 is coupled to an RF output 27 of VCR 5 from which it can be coupled to a television receiver (TV) such as TV 29 shown in FIG. 1b." (col 3, lines 7 – 18). Here channel 3 or 4 list a first channel and the programming performed by VCR is the second channel. The first channel is unrecognized by the second channel because if this was not so, programming could not have been performed.

Hence claims 1 and 8 stay rejected.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 - 15 and 18 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (US 4706121) in view of Beyers JR. (US 4641205) and further in view of Yuen et al (US 5307173)

Regarding **claim 1**, Young discloses a system for controlling a television tuner (fig 3) comprising:

an on-screen television (fig 3, 126 illustrates on-screen television) scheduling system separate from the television configured to generate a display of television schedule information including listings of television programs in a guide format and receive a user selection of a displayed television program listing as a first channel (col 3, lines 7 – 10, col 4, lines 36 – 44, col 4, lines 61 – 66, col 6, lines 18 – 23 and col 6, lines 60 – 64 illustrate scheduling system separate from tuner)

a control signal means for transmitting the second channel selection command to the television tuner for causing the tuner to tune to the selected television program (col 4, lines 46 – 52, col 5, lines 5 – 15 and col 7, line 60 to col 8, line 23 illustrate tv tuner)

However Young does not disclose channel selection command unrecognizable

by the television tuner.

On the other hand Beyers JR. teaches channel selection command unrecognizable by the television tuner (col 3, lines 7 – 18, see details above)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate channel selection command unrecognizable by the television tuner as taught by Yuen et al into the system of Young in order to appropriately program the required channel.

The combination of Young and Beyers JR. do not disclose means coupled to the on-screen television scheduling system for converting the first channel selection command to a second channel selection command recognizable by the television tuner

On the other hand, Yuen et al, teaches a conversion table stored in the memory for converting the assigned numbers of each cable channel of the television guide such as HBO, ESPN, etc. to the channel number of the local cable carrier in order to tune the VCR to the correct channel (col 16, line 53 to col 18, line 7)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the conversion table as taught by Yuen et al into the combined system of Young and Beyers JR. in order to accurately record the television program in attended recording mode.

Regarding **claim 2** the combination of Young, Beyers JR. and Yuen et al disclose all of the features of the instant invention as discussed in claim 1 above except for wherein the on-screen television scheduling system resides in a recording means.

Yuen et al further teaches that another preferred embodiment of the invention is

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to embed the decoding means into various equipments associated with television, such as a video cassette recorder, cable box or satellite receiver because the decoding means would only have to be present in one of the equipments, such as the cable box, which would then at the appropriate time distribute the power command to the other equipments such as VCR and a satellite receiver to record the desired program (figs. 32 – 35, col 32, line 42 to col 33, line 16 and col 33, line 62 to col 34, line 45)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of embedding the decoding means into various equipments associated with television as taught by Yuen et al into the combined system of Young and Beyers JR. in order to use only one controlling means in one of the equipments to control other equipments.

Claim 3 is rejected for the same reasons as discussed in claim 2 above because Yuen et al teaches that the decoding means can be embedded in the cable decoder (figs. 32 – 35, col 32, line 42 to col 33, line 16 and col 33, line 62 to col 34, line 45)

Claim 4 is rejected for the same reasons as discussed in claim 1 above because Yuen et al teaches the claimed memory storing a conversion code for converting the first channel selection command to the second channel selection command (col 16, line 53 to col 18, line 7)

Regarding **claim 5** Young discloses the claimed wherein the on-screen television scheduling system is configured to receive a desired activation time for the selected television program (col 7, line 60 to col 8, line 22, col 9, line 48 to col 10, line 10 and col 15, line 20 to col 16, line 44)

Regarding **claim 6** Young discloses the claimed wherein the control signal means transmits the second channel selection command at the activation time (col 7, lines 60 – 64)

Regarding **claim 7** Young discloses the claimed means for supplying recording commands to a recording means at the activation time (col 7, lines 60 to col 8, line 22)

Method **claims 8 – 14** are rejected for the same reasons as discussed in apparatus claims 1 – 7 above.

Regarding **claim 18** Young discloses the method, wherein the first channel selection command is received from a wireless signal (col 5, lines 5 – 10 wireless remote controller)

Regarding **claim 19** Young, Beyers JR. and Yuen et al disclose the method, wherein a format of the first channel selection command is incompatible with the television tuner and wherein a format of the second channel selection command is compatible with the television tuner (see claim 1 above)

Regarding **claim 20** Young, Beyers JR. and Yuen et al disclose the method (see claim 1 above) and furthermore Beyers JR. discloses wherein the first channel selection command includes instructions to tune to a corresponding channel and wherein the instructions are unrecognizable by the television tuner (col 3, lines 7 – 18, see argument above)

Claim 15 is rejected based on claim 1 above

4. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (US 4706121) in view of Beyers JR. (US 4641205) in view of Yuen et al (US 5307173) and further in view of Park (US 5193009)

Regarding **claim 16** Young discloses the method, further comprising while tuned to a control channel (col 4, lines 46 – 52, col 5, lines 5 – 15 and col 7, line 60 to col 8, line 23 illustrate control channel)

However Young, Beyers JR. and Yuen et al do not disclose receiving, at a recording means, instructions for recording a first user-selected television program broadcast on a first television channel and a second user-selected television program broadcast on a second television channel, wherein the recording means is capable of recording the first television program and the second television program

On the other hand Park teaches receiving, at a recording means, instructions for recording a first user-selected television program broadcast on a first television channel and a second user-selected television program broadcast on a second television channel, wherein the recording means is capable of recording the first television program and the second television program (col 2, lines 12 – 33 illustrate recording two television programs)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate receiving, at a recording means, instructions for recording a first user-selected television program broadcast on a first television channel and a second user-selected television program broadcast on a second television channel, wherein the recording means is capable of recording the first television program and

the second television program as taught by Park into the combined system of Young, Beyers JR. and Yuen et al in order to enable simultaneous recording of two programs.

Regarding **claim 17** Young discloses a fixed control channel (col 4, lines 46 – 52, col 5, lines 5 – 15 and col 7, line 60 to col 8, line 23 illustrate control channel)

However Young, Beyers JR. and Yuen et al do not disclose first television channel and the second television channel.

On the other hand Park teaches first television channel and the second television channel (col 2, lines 12 – 33 illustrate recording two television programs)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate first television channel and the second television channel as taught by Park into the combined system of Young, Beyers JR. and Yuen et al in order to enable simultaneous recording of two programs.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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/S. Y. H./
05/31/2011

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2484